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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,120	12/21/2000	Chikara Uratani	36856.422	9930

7590

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EXAMINER

GILMAN, ALEXANDER

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,120

Applicant(s)

URATANI ET AL.

Examiner

Alexander Gilman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuriyama et al. With regard to claims 1-3, 11, and 14, Kuriyama et al (US Pat. No. 6,068,499) disclose an electronic component comprising:

an insulative case (2) made of resin;

a plurality of surface-mounting terminals (12, 11) mounted on said insulative case;

at least one notch provided in said insulative case to accommodate a lead portion of at least one of surface-mounting terminals; and

said notch defining a clearance (Fig. 2,) between the solder fillet portion of (11, 12) and lower-side insulative case (2b).

With regard to claims 21 and 22, Kuriyama et al disclose a notch defining a clearance in a first direction Kuriyama et al do not disclose that the notch is extending entirely through the insulative case in the second direction.

The above mentioned limitation is not patentably significant since they relate to the size of the article under consideration which is not ordinarily a matter of invention. In re Yount, 36 C.C.P.A. (Patents) 775, 171 F.2d 317, 80 USPQ 141.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

With regard to claims 12, 13, and 18, Kuriyama et al disclose all of the limitations as applied to claims 1-3, plus a surface-mounting external terminal (40).

With regard to claims 4-6, 15, and 16, Kuriyama et al disclose the two portions (2a, 2b) of the insulative case, plurality of terminals (4, 5) and a groove (8, 9) which is substantially V-shaped.

With regard to claims 7-10, and 17, Kuriyama et al disclose the first notch and the second notch receiving lead portions respectively of the movable (5) and fixed (4) terminals.

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With regard to claims 19 and 20, Kuriyama et al disclose a communication device (col. 1, lines 15-17) comprising a coaxial connector (Fig. 7a; col. 1, line 6).

Response to Arguments

Applicant's arguments filed 02/28/2003 have been fully considered but they are not persuasive.

Applicants argue that, since parts of vertical portion of the terminals are in contact with the housing 2 of Kuriyama et al, the notch does not prevent from wicking effect. Hence, as Applicants assume, the functions performed by the notch in the prior art and in the invention are different.

Examiner respectfully submits that Kuriyama et al notch and the invention's notch perform the same function – antiwicking. No other structural limitations prove a necessity of the Kuriyama et al notch being significantly wider than the terminal except for preventing wicking. The existent size of the notch deems to prevent the capillary effect, since this effect can be developed if the capillary size distance between terminal and the housing is formed continuously starting from the bottom of the housing. Hence, if the vertical extension is not necessary, the elimination of the part of notch, which serves as a protection against capillary effect, is an obvious expedient since it has been held that omission of an element and its function (only function of the wide notch is antiwicking) in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

If, the extension is necessary, it would be matter of a routine experimentation to extend the Kuriyama et al notch in the vertical direction.

Applicants' argument that the vertical extension would make the device completely inoperative is not supported. The vertical extension of the notch does not structurally affect function of the terminals since they supported on the bottom and on top. Presence or absence of the vertical portion of the notch does not affect flexibility of the cantilever moving terminal .

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and

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does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner respectfully submits that necessity of notch, as antiwicking means, is illustrated by Kuriama et al. Extending notch

As it was shown in section 1 of this Action, the extension of the notch at the full thickness of the insulative case is not patentably significant since they relate to the size of the article under consideration which is not ordinarily a matter of invention.

Since all of structural limitations of the invention, including anti-capillary notch, are met by Kuriama et al, extending the notch in vertical direction is a matter of routine experimentation and using the court decisions (*In re Yount*, 36 C.C.P.A. (Patents) 775, 171 F.2d 317, 80 USPQ 141) and (*In re Aller*, 105 USPQ 233) deems to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Gilman whose telephone number is (703) 305-847. The examiner can normally be reached on Monday-Friday, 10:00 a.m - 7:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where

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this application or proceeding is assigned are (703) 308-7322 for regular communications and (703) 308-7322 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

Alexander Gilman


May 16, 2003